

REMARKS

Claims 1-20 are pending in this application. By this Response, Applicants are amending claims 1, 7 and 17. Accordingly, claims 1-20 are at issue. Applicants respectfully submit no new matter was added by these amendments.

The Examiner has objected to the Title of the application as not being descriptive. By this Response, Applicants have amended the Title of the application. Accordingly, Applicants respectfully submit this objection is moot.

The Examiner has rejected claims 1-20 under 35 U.S.C. 112, first paragraph. Specifically, the Examiner maintains that “object module human-machine interface application” (hereafter “object module”) is not properly described in the application. Applicants respectfully traverse this rejection.

As set forth with respect to a preferred embodiment of the invention, the Application explains the “object module” is “code, preferably a Java-like program module, that is transmitted to, and activated at, its destination receiving device.” (Application, p. 3). The Application further describes the functionality of the object module is “to notify and request intervention by operator personnel.” (Application, p. 3).

Additionally, the Application teaches that the object module “has a defined data type and data structure that includes both data and functions.” (Application, p. 4). The Application gives several examples, such as “a file containing extensible markup language (XML),” etc. (Application, p. 4).

One skilled in the art would clearly understand the invention based on the description provided in the specification, which sets forth the function of the object module and various well known languages (e.g., Java, XML) for implementing function. Moreover, the Examiner has failed to provide any basis for suggesting one skilled in the art would not understand the invention or that the inventor did not have possession of the claimed invention. Accordingly, Applicants respectfully request removal of this rejection.

The Examiner has rejected claims 1-2, 5-9, 12-13 and 17-20 under 35 U.S.C. 103(a) as being unpatentable over Lewis. Applicants respectfully traverse this rejection.

Claim 1 is directed to a method for notifying an operator of an automation network of a problem requiring human intervention. In this regard, claim 1 requires “transmitting an object module human-machine interface application . . . to a receiving device.” As described with respect to a preferred embodiment, claim 1 has been amended to clarify that the module for requesting human intervention (as explained in the description) is also “activated at, its destination receiving device.” (Application, p.3). Claim 1 was also amended to clarify the object module included both data and functions (e.g., such as an XML or HTML file).

Contrary to the Examiner’s position, Lewis fails to disclose the method of claim 1. Lewis is directed to a system wherein a “network management server 12” monitors a “live network 10” and sends “alarms” to an “alarm notification manager 14” over a “link 13.” The disclosure in Lewis is primarily concerned with implementing filters in the “alarm notification manager 14” to filter out routine or irrelevant alarms. The alarms that pass the filters are sent by the “alarm notification manager 14” to a “network management application 24” over “link 23.” As shown in Figure 2 of Lewis, the links “13” and “23” do not appear to be part of the “live network 10.”

Unlike the method of claim 1, as amended, there is no disclosure in Lewis of sending an object module human-machine interface application of an event requesting human intervention. That is, the object module human-machine interface application is not simply an “alarm” that may be filtered or passed through, but an application that includes both data and functions (see page 4, second full paragraph of the present application). Moreover, the receiving device of claim 1 is required to be “operably connected to the network.” Neither the “alarm notification manager 14” or the “network management application 24” of Lewis appear to be operably connected to the “live network 10.”

Additionally, there is no suggestion that the filters of Lewis would work on the object module human-machine interface application required in claim 1 because the object module includes both data and functions. Accordingly, any such filters would be inoperable for their intended purpose, or would require modifications to handle the object modules of the present invention. There must be some incentive or motivation to make such modifications.

In view of the above comments, Applicants respectfully submit claim 1 is patentable over Lewis. Claims 2 and 5-6 depend on claim 1 and include each of its limitations. Accordingly, Applicants respectfully submit claims 2 and 5-6 are also patentable over Lewis.

Claims 7 and 17 have been amended herein to include similar limitations to the ones added to claim 1. Accordingly, Applicants respectfully submit claims 7 and 17 are also patentable over Lewis. Claims 8-9 and 12-13 depend on claim 7 and include each of its limitations, and claims 18-20 depend on claim 17 and include each of its limitations. Accordingly, Applicants respectfully submit claims 8-9, 12-13 and 18-20 are also patentable over Lewis.

The Examiner has rejected claims 3-4, 10-11 and 15 under 35 U.S.C. 103(a) as being unpatentable over Lewis in view of Mukaiyama. Applicants respectfully traverse this rejection.

As set forth above, Applicants respectfully submit claims 1 and 7 are patentable over Lewis.

The Examiner cites to Mukaiyama to cure the deficiencies of Lewis. However, the Examiner fails to meet his burden of showing an incentive or motivation to combine Lewis with Mukaiyama. Instead, the Examiner simply asserts it would have been obvious to combine features of Mukaiyama with those of Lewis.

The combination of Lewis with Mukaiyama is improper because there is no motivation or incentive in the prior art to combine these references in the manner suggested by the Examiner. See *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1785 (Fed. Cir. 1995).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Here, there is absolutely no incentive in the cited references to combine the references in the manner suggested by the Examiner. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP 2143.01. Second, there must be a reasonable expectation of success. See MPEP 2143.02. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. See MPEP 2143.03. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner bears the initial burden on factually supporting any *prima facie* conclusion of obviousness. See MPEP § 2142. In the present case, the Examiner failed to meet this burden.

Contrary to the Examiner's position, it would not have been obvious to combine Mukaiyama with Lewis. As set forth above, Lewis is primarily concerned with filtering alarms. There is no suggestion that the filtering system of Lewis is equipped to filter or otherwise handle modules having both data and functions, such as the Java applets used in Mukaiyama. Moreover, there is no suggestion for such modules to perform the claimed functions. Accordingly, Applicants respectfully submit claims 1 and 7 are also patentable over Lewis in view of Mukaiyama.

Claims 3-4 depend on claim 7 and include each of its limitations, and claims 10-11 and 15 depend on claim 7 and include each of its limitations. Accordingly, Applicants respectfully submit claims 3-4, 10-11 and 15 are also patentable over Lewis in view of Mukaiyama.

The Examiner has rejected claims 14 and 16 under 35 U.S.C. 103(a) as being unpatentable over Lewis in view of Lee. Applicants respectfully traverse this rejection.

As set forth above, Applicants respectfully submit claim 7 is patentable over Lewis. Lee is cited only for disclosure of providing a wireless network, and fails to cure the deficiencies of Lewis. Accordingly, Applicants respectfully submit claim 7 is patentable over Lewis in view of Lee.

Claims 14 and 16 depend on claim 7 and include each of its limitations. Accordingly, Applicants respectfully submit claims 14 and 16 are also patentable over Lewis in view of Lee.

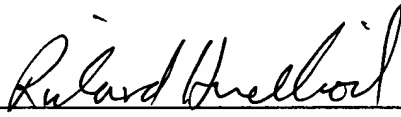
CONCLUSION

In light of the foregoing Amendments and Remarks, Applicants respectfully submit pending claims 1-20 are in condition for allowance. The Examiner is invited to contact the undersigned if there are any questions concerning this Response.

The Commissioner is authorized to debit or credit Deposit Account No. 23-0280 for any payment **deficiencies or overpayments** associated with this matter.

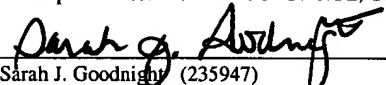
Respectfully submitted,

Dated: November 28, 2005

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: MAIL STOP RCE, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on November 28, 2005.


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